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REMARKS

Entry of this Amendment is proper since it narrows the issues on appeal and does not require a further search by the Examiner.

Claims 1-13 and 21-27 are all the claims presently pending in the application. Claim 2 has been amended to address a minor typographical error. Claim 27 has been withdrawn from consideration.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-13 and 21-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brick et al. (U. S. Patent No. 6,269,342) in view of Adamec et al. (U.S. Patent No. 6,211,773).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (as recited, for example, in claim 1) is directed to a system for restocking and repricing merchandise. The system includes a shelf label holder including an illuminating device for performing an illuminating function, and a hand-held unit which remotely causes said illuminating device to illuminate under a predetermined condition.

Importantly, the illuminating device includes a plurality of illuminating sections which correspond respectively to locations on a shelf (Application at Figure 2; page 6, lines 1-18).

Conventional systems for restocking and/or repricing merchandise use an electronic tag which is affixed to the shelf near the merchandise so that the price of the merchandise can be changed electronically. However, these systems are expensive and fragile and do not help to guide the store clerk to a particular shelf location (Application at page 2, lines 3-11).

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The claimed invention, on the other hand, includes a shelf label holder having an illuminating device which includes a plurality of illuminating sections which correspond respectively to locations on a shelf. This feature may help guide a store clerk to a correct store location for restocking and/or repricing merchandise (Application at page 2, lines 13-16).

II. THE RESTRICTION REQUIREMENT

The Examiner alleges that claim 27 is independent and distinct from the originally claimed invention and thus, has withdrawn claim 27 from consideration. Applicant submits, however, that the Examiner has failed to show that claim 27 may be withdrawn and not examined.

Indeed, the Examiner alleges that *"the combination as claimed does not require the particulars of the subcombination as claimed because a system in accordance with Invention II need not be capable of remotely causing the shelf label holder to illuminate under a predetermined condition"*.

However, Applicant would point out that under MPEP §806.05(c) an invention may be considered "distinct" only if the combination "does not require the particulars of the subcombination as claimed for patentability". Nowhere has the Examiner made such an allegation. That is, the examiner merely states that "a system ... need not be capable of remotely causing the shelf label holder to illuminate". Nowhere does the Examiner allege that the system does not need the "shelf label holder" to be patentable. Therefore, Applicant submits that even assuming (arguendo) that the Examiner's statement is correct, the Examiner has failed to meet his burden under MPEP §806.05(c).

Moreover, Applicant would point out that the Examiner has completely neglected and totally ignored a very important requirement of MPEP §806.05(c). Namely, MPEP §806.05(c) states that:

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"[t]o support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search" (emphasis added).

Nowhere has the Examiner alleged any reason for insisting on restriction. Indeed, Applicant would point out that claim 2, like claim 27, recites a "host controller" and thus, it is clearly unreasonable to suggest that examining claim 27 would add any undue burden on the Examiner. Therefore, Applicant again submits that the Examiner has clearly failed to meet his burden under MPEP §806.05(c).

In view of the foregoing, the Examiner is respectfully requested to withdraw the restriction requirement.

III. BRICK AND ADAMEC

The Examiner alleges that Brick would have been combined with Adamec to form the invention of claims 1-13 and 21-26. Applicant submits, however, that these references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Brick discloses an electronic pricing and display system which uses programmable electronic shelf tags 10 which are attached directly to a shelf and an apparatus for programming the tags (Brick at Abstract). Each shelf tag is associated with a particular product, and includes an electronic display 26 for displaying pricing information for the product (Brick at col. 4, lines 26-33; col. 12, lines 52-56). A programming device 200 may be used to change the information displayed by the display (Brick at col. 7, lines 60-62).

Adamec discloses a remote control device 24 for an electronic price label (EPL) system. Each electronic price label corresponds to an item of merchandise (Adamec at col. 1, lines 19-21). The device 24 (i.e., **not the electronic price label 18**) includes portions 50a and 50b which include indicators 45a and 45b, respectively (Adamec at Figure 2a; col. 3, line 66-col. 4, line 52).

Contrary to the Examiner's allegations, these references would not have been combined to form the claimed invention. Specifically, Brick is directed to a shelf tag associated with a

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particular product, and Adamec is directed to an EPL system which is intended to allow an operator to control an EPL computer from anywhere in a store (Adamec at col. 2, lines 40-44). Thus, Brick is completely unrelated to Adamec, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant would submit that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, contrary to the Examiner's allegations, neither of these references teach or suggest their combination. Therefore, Applicant would respectfully submit that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Brick, nor Adamec, nor any alleged combination thereof teaches or suggests a shelf label holder having an illuminating device which *"comprises a plurality of illuminating sections which correspond respectively to locations on a shelf"*, as recited in claim 1. As noted above, this feature may help guide a store clerk to a correct store location for restocking and/or repricing merchandise (Application at page 2, lines 13-16).

Clearly, the cited references do not teach or suggest this novel feature. Indeed, the Examiner concedes on page 3 of the Office Action that Brick does not teach or suggest this feature, but alleges that Adamec teaches this feature. The Examiner is clearly incorrect.

First, Applicant would point out that Adamec teaches that hand-held terminals have problems which he allegedly addresses by instead using a remote control device 24 (Adamec at col. 1, line 66-col. 2, line 9). Therefore, Adamec teaches away from the claimed invention.

Further, Adamec is directed to an "electronic price label" system. Adamec states that *"EPLs typically display the price of corresponding merchandise items on store shelves and are typically attached to a rail along the leading edge of the shelves"* (emphasis added) (Adamec at col. 1, lines 19-23).

However, the shortcomings of such an EPL system are clearly discussed in the Background section of the present Application. Namely, the Background section refers to an electronic price label as an "electronic shelf tag" and states that these tags are **expensive and**

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cannot provide the same amount of information as a paper shelf label (Application at page 2, lines 7-8). Moreover, the Application states that *"like paper labels, such electronic tags do not help guide the store clerk to the correct shelf location"* (emphasis added) (Application at page 2, lines 11-12).

Therefore, the Application clearly describes the shortcomings of the EPL system in Adamec. Namely, the EPL system in Adamec is expensive and cannot provide the same information as a paper shelf label. Moreover, the electronic price labels in Adamec **do not help guide the store clerk to the correct shelf location.**

Indeed, the Background section discusses the problems that store clerks have in locating a proper shelf location for restocking merchandise (Application at page 1, lines 10-17). Specifically, the Background section states that large stores spend about 100 man-hours per week on price changes and "about 20-30% of this time is spent **searching for the shelf on which the merchandise to be restocked or repriced is located**" (emphasis added) (Application at page 1, lines 15-17).

An object of the exemplary aspects of the claimed invention to address this problem by helping the store clerks to be able to reduce the time spent searching for the shelf on which merchandise is located. However, nowhere does Adamec even recognize such a problem exists, let alone offer a solution to the problem. Instead, the object of Adamec is merely to provide a remote control device that would allow an operator to control an EPL computer from anywhere in a store (Adamec at col. 2, lines 40-44). The Adamec system has nothing to do with helping a store clerk locate the shelf on which the merchandise to be restocked or repriced is located.

Further, the Examiner attempts to rely on col. 4, line 32 et seq. in Adamec to support his position that Adamec teaches a shelf label holder having "a plurality of illuminating sections" as in the claimed invention. Specifically, the Examiner alleges that the indicators 45a and 45b in Adamec provide the illuminating function as in the claimed invention. However, this is clearly incorrect.

In fact, it is very important that the Examiner understand that the indicators 45a and 45b in Adamec are not included in the EPL, but in the remote device 24. Indeed,

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Figures 2A and 2B in Adamec clearly identify the features therein as illustrating the features of the remote control device 24, not the features of an EPL 18. That is, Adamec teaches that the device 24 is a combination of the components of two EPLs.

Specifically, Adamec merely states that these indicators 45a and 45b are "preferably an optional alternative or addition to displaying of acknowledgements by displays 46a and 46b" in the remote control device (Adamec at col. 4, lines 32-34). Adamec states that displays 46a and 46b are used "to signal an operator that EPL computer 12 has executed a desired function in response to a command message from device 24" (Adamec at col. 4, lines 22-24).

That is, Adamec merely teaches that an operator of the remote control device 24 may view the indicators 45a and 45b **on the remote control device 24 (i.e., not on the EPL 18)** to confirm that the computer 12 has executed a desired function. Thus, nowhere does Adamec teach or suggest that the remote control device 24 remotely causes an indicator on an EPL to illuminate.

Further, even assuming that the portions 50a and 50b which may represent an EPL in Figures 2A and 2B may include the indicators 45a and 45b, it is clear that each of the EPLs 50a and 50b include only one indicator. Thus, nowhere does Adamec teach or suggest an EPL having an illuminating device having a plurality of illuminating sections. Moreover, Adamec certainly does not teach or suggest a plurality of illuminating sections which correspond respectively to locations on a shelf, as in the claimed invention.

Moreover, Applicant would point out that it is a "shelf label holder" and not necessarily a "shelf label" which includes the illuminating device in the claimed invention. Indeed, as illustrated in Figure 2 of the Application, **in the exemplary aspects of claimed invention the shelf label 220 may be merely a paper or plastic label inserted into the shelf label holder 200**. Thus, even assuming (arguendo) that Adamec somehow teaches an EPL having an illuminating device with a plurality of illuminating sections, Adamec certainly does not teach or suggest a holder which holds the EPL and includes such an illuminating device.

Therefore, Applicant submits that these references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of

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the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

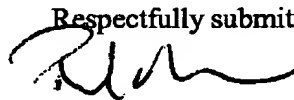
III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-13 and 21-27, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Please charge any deficiencies in fees and credit any overpayment of fees to Assignee's Deposit Account No. 50-0510.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Gerald O'Connor, Group Art Unit # 3627 at fax number (571) 273-8300 this 9th day of September, 2005.



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